Docket No. F-7234 Ser. No. 10/074,137

REMARKS

The following is in response to the Advisory Action of July 19, 2006.

The Examiner cites *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971) for the proposition that an obviousness which includes hindsight reasoning is appropriate so long as the reasoning only includes what is within the ordinary skill in the art. To this, Applicant responds as follows.

Regarding the Examiner's reliance on *McLaughlin*, Applicant asserts that such a reliance is misplaced. In *McLaughlin*, the PTO was able to provide a plurality of references taught the claimed limitations as combined. 170 USPQ at 212. The court's comments about hindsight being appropriate are based on what was well known was supported by the actual teachings of the secondary references. Here, in support of the admitted hindsight analysis, the Examiner offers no secondary reference to support the modifications to the primary reference (Wells). Such differences between the present situation and *McLaughlin* renders that case not applicable here. Accordingly, the hindsight analysis applied by the Examiner here, one which is not based on what the art actually teaches but what the Examiner asserts without support about what the art teaches, is not proper. *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998)(requiring the Examiner

to provide referencces that both teach the limitations in the claims and suggest combining their respcctive teachings "stands as a critical safeguard against hindsight analysis and rote application of thc legal test for obviousness"); *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (BPAI 1984) ("the art, without the benefit" of Applicant's specification, must provide thc suggestion to "make the necessary changes in the refcrence device" and produce thc claimed invention).

Moreover, a contention about what is already known in the art is only proper where the underlying facts are so well-known as to be capable of instant and unquestionable demonstration as to defy dispute. *In re Alhert*, 424 F.2d 1088, 1091, 165 U.S.P.Q. 418 (CCPA 1970). However, in a circumstance involving a game machinc and an implementation allowing a user to operate the game machine based on personal information, such as with the present invention, the Examiner must providc concrete evidence to support such a rejection. *Id.*, at 1091; *In re Zurko*, 258 F.3d 1379, 1385, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001).

Furthermore, the Examiner comments that "in one embodiment of Wells" (taught in col 12 lines 52-61) the game is played on the mobile communications terminal while "in a second embodiment of Wells" (col 2, lns 25-34, col 8, ln 47-col 9, ln 10, and col 11, lns 55-67) a game is played on the game play portion. This is a misrepresentation by the Examiner. The information in col 2 is merely

a discussion of the known art, not an embodiment in Wells. The remainder of the cited text illustrates that the exclusive purpose of the reference is to allow a user to play on a portable device. When the user does not wish to continue playing on the portable device, the user can return to regular play on the game machine. However, returning to the regular game play in Wells is not disclosed as a "second embodiment" but merely a way to terminate play on the portable device.

In reviewing Wells, the reference provides for no embodiment where the portable device serves any purpose whatsoever unless a game is being played in the device. Accordingly, modifying Wells so that a user *only* plays on the game machine would completely obviate the purpose of Wells and render the portable device a useless implement. However, this scenario exactly describes the invention. That is, the claims recite playing the game on the game machine and only using the portable device as a means for obtaining authorization to use the game machine. As such, Wells, without the benefit of the pending application, fails to teach the claimed invention and therefore fails to render obvious the claimed invention. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (to establish a *prima face* case of obviousness, three basic criteria must be met: there must be a suggestion or motivation to modify the references to provide the claimed invention; there must be a reasonable expectation of successfully providing

the invention as claimed; and *the references must teach all of the claimed limitations*).

The following is in response to the final Office Action of May 1, 2006.

Claims 1-3, 6, 7, 10, 11, 13-15 and 17-24 are pending, including independent claims 1, 2, 10-11 and 21-24, and the independent claims have been objected to for reciting "communications" rather than "communication". Applicant has amended the claims as required.

The claims remain rejected under 35 USC § 103(a) as being unpatentable over Wells (USPN 6846238).

In the rejection, the Examiner acknowledges that Wells fails to teach playing a game exclusively on a game play portion. This is because during remote play, the user is playing on the remote, mobile device. However, the Examiner asserts that such would be an obvious modification of Wells to allow the user to terminate a game on the mobile terminal and play on the game machine during local game play.

Applicant disagrees with the Examiner's reasoning because the Examiner does not provide any references to support the obviousness proposition. The Examiner's sole evidence is the disclosure of the pending application and not based on knowledge in the art so that it is inferred that improper hindsight reasoning is applied. *In re Leonard R. Kahn*, 441 F.3d 997 (Fed. Cir. 2006) (it is inferred that hindsight reasoning is applied unless there is an explanation by the Examiner of the motivation or the suggestion or teaching of why the skilled artisan would combine the references to form the claimed invention); *Rouffet*, 149 F.3d at 1350 (requiring the Examiner to provide references that both teach the limitations in the claims and suggest combining their respective teachings "stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness"); *Chicago Rawhide Mfg. Co.*, 223 USPQ at 353 ("the art, without the benefit" of Applicant's specification, must provide the suggestion to "make the necessary changes in the reference device" and produce the claimed invention).

Moreover, the proposed modification exactly contradicts the purpose of the Wells invention which is solely directed to playing a game on a portable game station. Such purpose is inapposite with the purpose of the invention which is directed to enabling a person to play a game on a stationary game machine and which uses a mobile device *only* to enable the user to play on the stationary machine. Accordingly, such a modification of Wells to provide the claimed

invention is not acceptable. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983) (a "reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention"); *In re Leonard R. Kahn*, 441 F.3d 997 (Fed. Cir. 2006) (a reference teaches away when the skilled artisan would be "discouraged from following the path set out in the reference, or would be led in a direction divergent from the path taken by the applicant").

Although Applicant disagrees with the Examiner, Applicant has amended the independent claims to render the same patentable over the art. For example, the independent claims now recite (see e.g., Claim 24):

> "a control portion disposed on said game play portion said control portion identifying the user on the basis of the input of personal information by said mobile communication terminal, said control portion thereafter making a call to the Internet service provider;
>
> responsive to the user being on the lists of subscribers and said game start approval button being operated, said control portion actuating a game credit switch disposed within said game play portion to enable the game play by said game play portion so that said game play portion is operable without the use of coins".

The above operation of the invention is not disclosed in Wells so that the claims are patentable thereover. *Vaeck,* 947 F.2d at 488 (to establish a *prima face* case of obviousness, three basic criteria must be met: there must be a suggestion or motivation to modify the references to provide the claimed invention; there must be a reasonable expectation of successfully providing the invention as claimed; and *the references must teach all of the claimed limitations*).

Applicant requests a one month extension of time. The fee of $120.00 for the extension is provided herewith in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

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